## REMARKS

### I. STATUS OF THE CLAIMS

After amendment, claims 1, 4, 5, 8, 9, 12-16, 18-29, 31, 64-66, 69-71, 73-76, 78-82 are pending. Applicants amended claim 28 to correct its dependency. Applicants amended claim 64 to recite that "the mixture comprises not more than 0.8% nitrogen gas by volume." Support for these amendments can be found at least in the specification as filed and original claim 28. Specifically, support for the amendment to claim 64 can be found at least at ¶¶ [0030-0034] of the specification as filed. Accordingly, no new matter has been added by the amendments made to the claims.

### II. OBJECTIONS

The Examiner objected to claim 28 because it is directed to a method of claim 25 but claim 25 is directed to a composition. In addition, the Examiner objected to claim 71 because it is missing a period at the end of the claim. Applicants have amended claim 28 to depend on claim 27 and have added a period to the end of claim 71. Accordingly, Applicants respectfully request that these objections be withdrawn.

### III. DOUBLE PATENTING

As an initial matter, applicants bring to the Examiner's attention that several of the applications and patents cited below (i.e., U.S. Patent Application Nos. 11/171,293, 11/225,860; U.S. Patent Nos. 6,572,873, 7,025,290) that form the basis of the outstanding Double Patenting rejections originally published as International Publication WO 00/72821, published on December 7, 2000.

**1. U.S. Patent Application 10/522,527**

Claims 1, 4, 5, 8, 9, 12-14, and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-17 of co-pending Application No. 10/522,527. Applicants respectfully traverse and request that the Examiner hold this rejection in abeyance. If this is the only rejection remaining following this amendment, Applicants request that the Examiner withdraw the rejection and permit the application to issue as a patent, thereby converting the provisional double patenting rejection in Application No. 10/522,527 into a double patenting rejection as required under M.P.E.P § 804.

**2. U.S. Patent Application 10/890,267**

Claims 1, 8, 18-20, and 24-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 11, 12, 14, and 21 of co-pending Application No. 10/890,267. Applicants respectfully traverse and request that the Examiner hold this rejection in abeyance. If this is the only rejection remaining following this amendment, Applicants request that the Examiner withdraw the rejection and permit the application to issue as a patent, thereby converting the provisional double patenting rejection in Application No. 10/890,267 into a double patenting rejection as required under M.P.E.P § 804.

**3. U.S. Patent Application 11/128,265**

Claims 1, 8, 9, 18-20, 26-28, and 31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7-18, 33, and 35-40 of co-pending Application No. 11/128,265. Applicants respectfully traverse and request that the Examiner hold this rejection in abeyance. If this is the only rejection remaining following this amendment, Applicants request that

the Examiner withdraw the rejection and permit the application to issue as a patent, thereby converting the provisional double patenting rejection in Application No. 11/128,265 into a double patenting rejection as required under M.P.E.P § 804.

**4. U.S. Patent Application 11/171,293**

Claims 64-66, 69-71, 73, 74, 76, 78, 79, and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 68, 69, 71, 72, 74-76, 80-82, 87, 88, 91-94, 96, 97, 100-102, and 107 of co-pending Application No. 11/171,293. Applicants respectfully traverse and request that the Examiner hold this rejection in abeyance. If this is the only rejection remaining following this amendment, Applicants request that the Examiner withdraw the rejection and permit the application to issue as a patent, thereby converting the provisional double patenting rejection in Application No. 11/171,293 into a double patenting rejection as required under M.P.E.P § 804.

**5. U.S. Patent Application 11/225,860**

Claim 64 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 11/225,860. Applicants respectfully traverse and request that the Examiner hold this rejection in abeyance. If this is the only rejection remaining following this amendment, Applicants request that the Examiner withdraw the rejection and permit the application to issue as a patent, thereby converting the provisional double patenting rejection in Application No. 11/225,860 into a double patenting rejection as required under M.P.E.P § 804.

**6. U.S. Patent Nos. 6,572,873 and 7,025,290**

Claims 64-66, 69, 70, 78, 79, 81, and 82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 7, 18, and 19 of U.S. Patent No. 6,572,873. Claims 64-66, 69, 70, 78, 79, and 82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7, and 8 of U.S. Patent No. 7,025,290. Specifically, for both rejections, the Examiner asserted that "[t]he difference between the instant invention and the patent are the ranges of the cross-sectional passages, density and half-life. In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists.'" Office Action at page 6 and 7.

While Applicants disagree with the merits of this rejection, in order to advance prosecution and without disclaiming any subject matter, Applicants amended claim 64 to recite that "the mixture comprises not more than 0.8% nitrogen gas by volume." With that amendment, Applicants respectfully submit that the rejection is moot and requests that the rejection be withdrawn.

## IV. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 1, 13, 15, 18, 19, 26, and 27 over *Cabrera Garrido* et al. (U.S. Patent No. 5,676,962). Specifically, the Examiner asserted that *Cabrera Garrido* teaches "in example 1 a microfoam preparation comprising a sclerosing agent in a bottle under oxygen pressure, together with a mixture of oxygen and carbon or other physiological gases. It is also taught that if the agent doesn't have a foaming

capacity, Polysorbate 20 can be used. Column 2, lines 16-21 teach examples of the agent such as polydocanol, sodium tetradecylsulfate, etc." Office Action at page 8.

The Examiner conceded that *Cabrera Garrido* does not "teach the concentration of the viscosity agent or the physiological gas." *Id.* But, the Examiner asserted that "determination of the concentrations of the viscosity agent and of the physiological gas would have been obvious to one of ordinary skill in the art at the time of the invention as part of normal experimentation to achieve the desired foam consistency." *Id.* at pages 8-9. Applicants respectfully traverse.

First, to establish a *prima facie* case of obviousness, the Office must articulate a clear, explicit reason why the claimed invention would have been obvious . M.P.E.P. § 2143. For this reason alone, this rejection should be withdrawn.

The M.P.E.P. lists a number of exemplary rationales that may support a conclusion of obviousness. *Id.* Because the Examiner conceded that not all elements are found in the prior art, the rationale most closely resembling the Examiner's assertion may be the "obvious to try" rationale. To reject a claim on this rationale, the Office must articulate, in addition to resolving the *Graham* factors, the following: (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem; (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem; (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and (4) whatever additional findings based on the *Graham* factual inquires may be necessary, in view of the facts of the case under consideration, to explain a conclusion of

obviousness. M.P.E.P. § 2143 (E). "If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." *Id.*

The Office failed to, among other things, articulate a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem, or a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

Furthermore, the mere fact that the reference *could* be modified does not render the modification obvious unless the prior art also suggests the desirability of the modification. M.P.E.P. § 2143.01. There is no mention in *Cabrera Garrido* of specific concentrations of specific gases or any mention that a viscosity enhancing agent is required in the foam, much less a suggestion that a composition of at least 20% vol/vol of at least one viscosity enhancing agent and a gas phase comprising at least 50% $CO_2$ would be suitable and/or desired.

For at least the above reasons, Applicants respectfully request withdrawal of the rejection as to claims 1, 13, 15, 18, 19, 26, and 27 under 35 USC § 103(a).

## V. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of claims 1, 4, 5, 8, 9, 12-16, 18-29, 31, 64-66, 69-71, 73-76, 78-82 and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: November 30, 2007

By: _____
Anthony C. Tridico
Reg. No. 45,958